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10/776,067	02/11/2004	Jeffrey D. Boschert	24319/81202	2099

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EXAMINER

HUSON, MONICA ANNE

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,067

Applicant(s)

BOSCHERT, JEFFREY D.

Examiner

Monica A. Huson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-36 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-36 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>061506</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the Amendment filed 11 September 2006.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Satija et al. (U.S. Patent 5,462,709), in view of Goldman et al. (U.S. Patent 4,318,945). Satija et al., hereafter "Satija," show that it is known to carry out a method for making an article (Abstract; Column 1, lines 47-48), comprising melting a translucent polymer material (Column 2, lines 49-53; Column 3, lines 2-3); extruding the melted translucent polymer material through a heated die (Column 2, lines 63-64; Column 6, lines 28-31); cooling the extruded translucent polymer material to solidify it (Column 6, lines 3-4, 57), whereby the article is formed from the extruded, solidified translucent polymer material (Column 6, lines 3-4). Satija does not show visually reproducing a coral through the molding process. Goldman et al., hereafter "Goldman," show that it is known to carry out a molding process for reproducing a rock formation (Column 1, lines 8-9, 15-16, 20, 45, 54-56; Column 2, lines 13-15; It is noted that coral is a type of rock formation.). Goldman and Satija are combinable because they are concerned with a similar technical field, namely, thermoplastic articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Goldman's

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thermoplastic rock formation with Satija's molding method in order to provide aquarium decorations that do not contain dirt or biological contaminants found in the natural coral.

Claims 20-25, 27-30, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willinger (U.S. Patent 4,699,829), in view of Rosato's Injection Molding Handbook (3rd ed.), further in view of Goldman. Regarding Claim 20, Willinger shows that it is known to carry out a method for making an article for use in an aquatic environment, wherein the article is configured to visually reproduce a type of aquarium life (Abstract), comprising molding a translucent material into a solidified desired article (Column 3, lines 17-18; Column 4, lines 50-56). Willinger does not show the specifics of the injection molding operation. Rosato shows that it is known to carry out a method comprising melting a polymer material, closing a mold, wherein the mold has one or more recesses that are in the desired configuration, injecting the melted polymer material into the mold, cooling the mold to solidify the polymer material, opening the mold, and removing the solidified polymer material (Page 4). Rosato and Willinger are combinable because they are concerned with a similar technical field, namely, methods of molding various articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Rosato's stepwise injection molding process to carry out Willinger's molding operation in order to properly form the desired articles and take advantage of injection molding technology. Willinger does not show visually reproducing a coral through the molding process. Goldman shows that it is known to carry out a molding process for reproducing a rock formation (Column 1, lines 8-9, 15-16, 20, 45, 54-56; Column 2, lines 13-15; It is noted that coral is a type of rock formation.). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Goldman's thermoplastic rock formation with Satija's molding method in

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order to provide aquarium decorations that do not contain dirt or biological contaminants found in the natural coral.

Regarding Claim 21, Willinger shows the process as claimed as discussed in the rejection of Claim 20 above, but he does not specifically show using a dye. Rosato shows that it is known to carry out a method further comprising injecting a dye into the mold (Page 506). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to include Rosato's dye injection step during Willinger's molding process in order to obtain the exact color that is desired for the end-use of the molded article.

Regarding Claims 22-24, Willinger shows the process as claimed as discussed in the rejection of Claim 21 above, but he does not specifically show using a dye. Rosato shows that it is known to carry out a method wherein the dye is injected as the polymer is injected (Page 506-507, 548-549). It is noted that selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). Therefore, it is being held that it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to inject die, as taught by Rosato, at any time during the molding process of Willinger in order to accommodate desired end-use specifications of the molded article.

Regarding Claim 25, Willinger shows the process as claimed as discussed in the rejection of Claim 21 above, but he does not specifically show using a die. Rosato shows that it is known to carry out a method wherein the dye comprises a color dye (Page 506). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Rosato's dye injection step during Willinger's molding process in order to obtain the exact color that is desired for the end-use of the molded article.

Regarding Claim 27, Willinger shows the process as claimed as discussed in the rejection of Claim 20 above, including a method further comprising

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attaching the solidified translucent polymer material to a base (Figure 2, element 34, 36), meeting applicant's claim.

Regarding Claim 28, Willinger shows that it is known to carry out a method for making an article for use in an aquatic environment, wherein the article is configured to visually reproduce a type of aquarium life (Abstract), comprising molding a translucent material into a solidified desired article (Column 3, lines 17-18; Column 4, lines 50-56). Willinger does not show the specifics of the injection molding operation. Rosato shows that it is known to carry out a method comprising closing a mold, wherein the mold has one or more recesses that are in the desired configuration, introducing a curable polymer material into the mold, heating the mold to solidify the curable polymer material, cooling the mold, opening the mold, and removing the solidified polymer material (Page 4). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Rosato's stepwise injection molding process to carry out Willinger's molding operation in order to properly form the desired articles and take advantage of injection molding technology. Willinger does not show visually reproducing a coral through the molding process. Goldman shows that it is known to carry out a molding process for reproducing a rock formation (Column 1, lines 8-9, 15-16, 20, 45, 54-56; Column 2, lines 13-15; It is noted that coral is a type of rock formation.). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Goldman's thermoplastic rock formation with Satija's molding method in order to provide aquarium decorations that do not contain dirt or biological contaminants found in the natural coral.

Regarding Claim 29, Willinger shows the process as claimed as discussed in the rejection of Claim 28 above, but he does not specifically show using a dye. Rosato shows that it is known to carry out a method further comprising injecting a dye into the mold (Page 506). It would have been prima facie

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obvious to one of ordinary skill in the art at the time the invention was made to include Rosato's dye injection step during Willinger's molding process in order to obtain the exact color that is desired for the end-use of the molded article.

Regarding Claim 30, Willinger shows the process as claimed as discussed in the rejection of Claim 29 above, but he does not specifically show using a die. Rosato shows that it is known to carry out a method wherein the dye comprises a color dye (Page 506). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Rosato's dye injection step during Willinger's molding process in order to obtain the exact color that is desired for the end-use of the molded article.

Regarding Claim 33, Willinger shows the process as claimed as discussed in the rejection of Claim 28 above, including a method further comprising attaching the solidified translucent polymer material to a base (Figure 2, element 34, 36), meeting applicant's claim.

Regarding Claim 35, Willinger shows that it is known to carry out a method for making an article for use in an aquatic environment, wherein the article is configured to visually reproduce a type of aquarium life (Abstract), comprising molding a translucent material into a solidified desired article (Column 3, lines 17-18; Column 4, lines 50-56). Willinger does not show the specifics of the injection molding operation. Rosato shows that it is known to carry out a method comprising melting a polymer material, closing a mold, wherein the mold has one or more recesses that are in the desired configuration, introducing the melted polymer material into the mold (Page 4), injecting air into the mold to cause the polymer material to coat one or more walls of the mold (Page 1219-1220), cooling the mold to solidify the polymer material, opening the mold, and removing the solidified polymer material (Page 4). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Rosato's stepwise injection molding process to carry out Willinger's molding operation in order to properly form the

desired articles and take advantage of injection molding technology. Willinger does not show visually reproducing a coral through the molding process. Goldman shows that it is known to carry out a molding process for reproducing a rock formation (Column 1, lines 8-9, 15-16, 20, 45, 54-56; Column 2, lines 13-15; It is noted that coral is a type of rock formation.). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Goldman's thermoplastic rock formation with Satija's molding method in order to provide aquarium decorations that do not contain dirt or biological contaminants found in the natural coral.

Claims 41, 42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willinger, in view of Rosato.

Regarding Claim 41, Willinger shows that it is known to carry out a method for making an article for use in an aquatic environment, wherein the article is configured to visually reproduce a type of aquarium life (Abstract), comprising molding a translucent material into a solidified desired article (Column 3, lines 17-18; Column 4, lines 50-56), wherein the type of aquarium life is a sea plant (Figure 2). Willinger does not show the specifics of the injection molding operation. Rosato shows that it is known to carry out a method comprising melting a polymer material, closing a mold, wherein the mold has one or more recesses that are in the desired configuration, injecting the melted polymer material into the mold, cooling the mold to solidify the polymer material, opening the mold, and removing the solidified polymer material (Page 4). Rosato and Willinger are combinable because they are concerned with a similar technical field, namely, methods of molding various articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Rosato's stepwise injection molding process to carry out Willinger's molding operation in order to properly form the desired articles and take advantage of injection molding technology.

Regarding Claim 42, Willinger shows that it is known to carry out a method for making an article for use in an aquatic environment, wherein the article is configured to visually reproduce a type of aquarium life (Abstract), comprising molding a translucent material into a solidified desired article (Column 3, lines 17-18; Column 4, lines 50-56), wherein the type of aquarium life is a sea plant (Figure 2). Willinger does not show the specifics of the injection molding operation. Rosato shows that it is known to carry out a method comprising closing a mold, wherein the mold has one or more recesses that are in the desired configuration, introducing a curable polymer material into the mold, heating the mold to solidify the curable polymer material, cooling the mold, opening the mold, and removing the solidified polymer material (Page 4). It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to use Rosato's stepwise injection molding process to carry out Willinger's molding operation in order to properly form the desired articles and take advantage of injection molding technology.

Regarding Claim 44, Willinger shows that it is known to carry out a method for making an article for use in an aquatic environment, wherein the article is configured to visually reproduce a type of aquarium life (Abstract), comprising molding a translucent material into a solidified desired article (Column 3, lines 17-18; Column 4, lines 50-56), wherein the type of aquarium life is a sea plant (Figure 2). Willinger does not show the specifics of the injection molding operation. Rosato shows that it is known to carry out a method comprising melting a polymer material, closing a mold, wherein the mold has one or more recesses that are in the desired configuration, introducing the melted polymer material into the mold (Page 4), injecting air into the mold to cause the polymer material to coat one or more walls of the mold (Page 1219-1220), cooling the mold to solidify the polymer material, opening the mold, and removing the solidified polymer material (Page 4). It would have been *prima facie* obvious to one of ordinary skill in the art at the

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time the invention was made to use Rosato's stepwise injection molding process to carry out Willinger's molding operation in order to properly form the desired articles and take advantage of injection molding technology.

Claims 26, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willinger and Rosato, further in view of Bomann (U.S. Patent 6,393,757).

Regarding Claim 26, Willinger shows the process as claimed as discussed in the rejection of Claim 20, but he does not show using a fluorescent dye. Bomann shows that it is known to carry out a method wherein the dye comprises a fluorescent dye (Column 14, lines 35-40). Bomann and Willinger are combinable because they are concerned with a similar technical field, namely, methods of molding aquarium life articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Bomann's fluorescent dye in Willinger's molding process in order to obtain the exact coloring that is desired for the end-use of the molded article.

Regarding Claim 31, Willinger shows the process as claimed as discussed in the rejection of Claim 29, but he does not show using a fluorescent dye. Bomann shows that it is known to carry out a method wherein the dye comprises a fluorescent dye (Column 14, lines 35-40). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Bomann's fluorescent dye in Willinger's molding process in order to obtain the exact coloring that is desired for the end-use of the molded article.

Regarding Claim 32, Willinger shows the process as claimed as discussed in the rejection of Claim 29, but he does not show using a glow in the dark dye. Bomann shows that it is known to carry out a method wherein the dye comprises a glow in the dark dye (Column 14, lines 34-36). It would have been

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prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Bomann's glow in the dark dye in Willinger's molding process in order to obtain the exact coloring that is desired for the end-use of the molded article.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willinger and Rosato, further in view of Yates (U.S. Patent 6,290,794). Willinger shows the process as claimed as discussed in the rejection of Claim 35, but he does not show filling the molded article with a gelatinous material. Yates shows that it is known to carry out a method comprising filling the solidified polymer material with a gelatinous material (Column 6, lines 3-16). Yates and Willinger are combinable because they are concerned with a similar technical field, namely, methods of molding pliable articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to follow Yates' filling step during Willinger's molding process in order to obtain the desired contour on the final article.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Satija, in view of Willinger. Satija shows that it is known to carry out a method for making an article (Abstract; Column 1, lines 47-48), comprising melting a translucent polymer material (Column 2, lines 49-53; Column 3, lines 2-3); extruding the melted translucent polymer material through a heated die (Column 2, lines 63-64; Column 6, lines 28-31); cooling the extruded translucent polymer material to solidify it (Column 6, lines 3-4, 57), whereby the article is formed from the extruded, solidified translucent polymer material (Column 6, lines 3-4). Satija does not show visually reproducing a coral through the molding process. Willinger shows that it is known to carry out a method wherein the type of aquarium life is a sea plant (Figure 2). Willinger and Satija are combinable because they are concerned with a similar technical

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field, namely, thermoplastic articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Willinger's thermoplastic sea plant with Satija's molding method in order to provide aquarium plants that do not contain dirt or biological contaminants found in the natural plants.

Response to Arguments

Applicant's arguments with respect to claims 20-36 and 41-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monica A Huson

November 27, 2006



CHRISTINA JOHNSON
SUPERVISORY PATENT EXAMINER

11/27/06